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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,592	12/13/2001	Victor B. Lortz	884.501US1	6044

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Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis, MN 55402

EXAMINER

DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
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2137

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09/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/022,592

Applicant(s)

LORTZ, VICTOR B.

Examiner

Zachary A. Davis

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 June 2008 has been entered.
2. By the above submission, Claims 1 and 9 have been amended. Claim 8 has been canceled. No claims have been added. Claims 1-7 and 9-14 are currently pending in the present application.

Response to Arguments

3. Applicant's arguments with respect to claims 1-7 and 9-14 have been considered but are moot in view of the new ground(s) of rejection.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is not sufficient antecedent basis in the specification for the newly added limitations in independent Claims 1 and 9 that “the first certificate is provided to the authorizer without interaction between the client and the third party with regard to the first certificate”. See below regarding the rejection under 35 U.S.C. 112, first paragraph, for failure to comply with the written description requirement for further detail.

Claim Objections

5. Claim 9 is objected to because of the following informalities:

Claim 9 ends with a semicolon followed by a period. The semicolon should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The rejection of Claim 8 under 35 U.S.C. 112, second paragraph, as indefinite is moot in light of the cancellation of the claim.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-7 and 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, Claims 1 and 9 have been amended to include the limitation "the first certificate is provided to the authorizer without interaction between the client and the third party with regard to the first certificate". However, there does not appear to be sufficient written description of this limitation in the specification as filed. It is noted that any negative limitation must have basis in the original disclosure. Although the specification appears to be silent as to whether there would be any interaction between the client and the third party as to the first certificate (in particular, it is noted that the term "interaction" appears to be absent from the specification entirely), the mere absence of a positive recitation is not basis for an exclusion. See MPEP § 2173.05(i). Further, Applicant has not pointed out where the amended claim language is supported in the specification, and, as noted above, there does not appear to be sufficient written description of the claim limitations in the application as filed. See MPEP § 2163.04.

Claims not specifically referred to above are rejected due to their dependence on a rejected base claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-7, 9, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGarvey, US Patent 6643774, in view of Lipkin et al, US Patent 6138235 (previously cited in the Office action mailed 14 July 2005).

In reference to Claim 1, McGarvey discloses a method including a client storing a first certificate from an authorizer, the client storing a URI associated with the first certificate and a third party, the client providing a certificate and the URI to the third party (see column 12, lines 22-26), determining if the third party's delegated ability to use the first certificate is authorized (column 3, line 58-column 4, line 10; column 12, lines 12-16, where tickets are only granted for certain authorized requests), and if the third party's delegated ability to use the first certificate is determined to be authorized, the client providing the first certificate directly to the authorizer in response to the authorizer accessing the URI, in which the client retains control over the third party's use of the first certificate, otherwise if the third party's delegated ability to use the first certificate is not authorized, then not providing the certificate (see Figures 3 and 8, where the client 300 corresponds to the client of the present claim, the server 310

corresponds to the third party of the present claim, and private key system 330 corresponds to the authorizer of the present claim; see also column 11, line 37-column 12, line 11, where, *inter alia*, the certificate is tunneled directly from the client to the private key system, i.e. authorizer; see also more generally column 3, line 58-column 4, line 10 and column 9, lines 52-58, for example). However, although McGarvey discloses that the first certificate is provided from the client directly to the authorizer (see column 11, line 37-column 12, line 11, cited above, by tunneling), McGarvey does not explicitly disclose that the certificate is provided without any interaction at all between the client and the third party.

Lipkin discloses a method for controlling access to services using certificates delegating authorization, that includes, *inter alia*, providing delegation certificates between a client and an authorizer without any interaction with a third party (see, for example, Figure 2, third communication, where the client sends the ticket, i.e. certificate, to the server, i.e. authorizer, without interaction with the system, i.e. third party; see also column 4, lines 1-59 in general). Because both McGarvey and Lipkin generally teach providing certificates delegating authorization from a client to a third party, it therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the provision of certificates without interaction (as in Lipkin) for the tunneling provision of certificates (as in McGarvey, which is still direct provision as claimed but is not "without interaction") in order to achieve the predictable result of the provision of the certificate. It is noted that the provision without interaction,

as in Lipkin, would have the additional predictable benefit of decreasing the number of individual communications that would be needed to provide the certificate.

In reference to Claims 2 and 3, McGarvey and Lipkin further disclose providing a short-term use certificate to the third party (McGarvey, column 12, lines 30-35; column 8, lines 8-13).

In reference to Claim 4, McGarvey and Lipkin further disclose authenticating the authorizer upon accessing the URI (McGarvey, column 11, lines 60-61).

In reference to Claims 5 and 6, McGarvey and Lipkin further disclose limiting and tracking the third party's use of the first certificate (McGarvey, column 8, lines 8-13).

In reference to Claim 7, McGarvey and Lipkin further disclose that the contents of the first certificate are not revealed to the third party (see McGarvey, column 11, lines 42-46).

In reference to Claim 9, McGarvey discloses a method including a client receiving a first certificate from an authorizer, the client generating a URI associated with the first certificate and a third party, the client providing a second certificate and the URI to the third party (see column 12, lines 22-26), and the client providing the first certificate directly to the authorizer upon the authorizer accessing the URI after the third party has provided the second certificate and URI to the authorizer (see Figures 3 and 8, where the client 300 corresponds to the client of the present claim, the server 310 corresponds to the third party of the present claim, and private key system 330 corresponds to the authorizer of the present claim; see also column 11, line 37-column

12, line 11, where, *inter alia*, the certificate is tunneled directly from the client to the private key system, i.e. authorizer). However, although McGarvey discloses that the first certificate is provided from the client directly to the authorizer (see column 11, line 37-column 12, line 11, cited above, by tunneling), McGarvey does not explicitly disclose that the certificate is provided without any interaction at all between the client and the third party.

Lipkin discloses a method for controlling access to services using certificates delegating authorization, that includes, *inter alia*, providing delegation certificates between a client and an authorizer without any interaction with a third party (see, for example, Figure 2, third communication, where the client sends the ticket, i.e. certificate, to the server, i.e. authorizer, without interaction with the system, i.e. third party; see also column 4, lines 1-59 in general). Because both McGarvey and Lipkin generally teach providing certificates delegating authorization from a client to a third party, it therefore would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the provision of certificates without interaction (as in Lipkin) for the tunneling provision of certificates (as in McGarvey, which is still direct provision as claimed but is not "without interaction") in order to achieve the predictable result of the provision of the certificate. It is noted that the provision without interaction, as in Lipkin, would have the additional predictable benefit of decreasing the number of individual communications that would be needed to provide the certificate.

In reference to Claim 12, McGarvey and Lipkin further disclose that the third party is granted access to a resource of the authorizer (McGarvey, column 8, lines 4-19).

In reference to Claim 13, McGarvey and Lipkin further disclose tracking a use of the second certificate (McGarvey, column 8, lines 8-13).

In reference to Claim 14, McGarvey and Lipkin further disclose that the second certificate can be revoked (McGarvey, column 8, lines 10-13; column 12, lines 30-36).

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGarvey in view of Lipkin as applied to claim 9 above, and further in view of Eastlake et al, "XML-Signature Syntax and Processing".

McGarvey and Lipkin disclose everything as applied above to Claim 9. However, neither McGarvey nor Lipkin explicitly discloses the use of XML signatures. Eastlake discloses that XML signatures can be used to apply digital signatures to the content of resources that may be external to the signature itself (page 4, section 1.0, "Introduction"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the method of McGarvey and Lipkin to include the use of XML signatures, in order to provide integrity and message or signer authentication (see Eastlake, page 1, Abstract).

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGarvey in view of Lipkin as applied to claim 9 above, and further in view of Ellison et al, "SPKI Certificate Theory".

McGarvey and Lipkin disclose everything as applied above to Claim 9. However, neither McGarvey nor Lipkin explicitly discloses the use of SPKI certificates. Ellison et al disclose that authorization certificates can be used to delegate authorizations (page 14, section 4, "Delegation") and that SPKI certificates can be used to define an authorization certificate (page 13, section 3.3, "SPKI Certificates"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the method of McGarvey and Lipkin to include the use of SPKI certificates, in order to allow for authorizations to be delegated without needing to involve the owner of the resource concerned (see Ellison, page 14, section 4).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Weeks et al, US Patent 7395550, discloses a trust management system using authorization certificates for delegation of authorization.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571)272-

3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Zachary A Davis/
Examiner, Art Unit 2137